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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,387	10/06/2005	Benoit Cyr	41313-1003	3825
25213	7590	06/28/2007		
HELLER EHRMAN LLP 275 MIDDLEFIELD ROAD MENLO PARK, CA 94025-3506			EXAMINER GITOMER, RALPH J	
			ART UNIT 1657	PAPER NUMBER
			MAIL DATE 06/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,387	Applicant(s) CYR, BENOIT	
	Examiner Ralph Gitomer	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 25-44 is/are pending in the application.
- 4a) Of the above claim(s) 31-35 and 40-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 25-30 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1657

Applicant's election with traverse of Group I, claims 1, 25-30, 36-39 in the reply filed on 5/16/07 is acknowledged. The traversal is on the ground(s) that the cited references do not teach every claimed feature. This is not found persuasive because the cited references teach the common technical feature of each group as is required.

The requirement is still deemed proper and is therefore made FINAL.

In view of the preliminary amendment filed 2/28/05, the claims considered here are 1, 25-30, 36-39. Please inform the examiner of all related cases, pending, allowed or abandoned. After resolution of the following issues, further searching and/or consideration may be required.

Newly submitted claims 31-35, 40-44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: In the previous restriction of 2/27/07 Group I was directed to a plant extract which was elected. New claims drawn to a library of plant extracts and formulations are distinct inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-35, 40-44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Art Unit: 1657

Applicant has elected MMP-9, Solidago spp. (Golden Rod), neoplastic cell migration species. It is noted that no claims presented are limited to the elected species.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 25-30, 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly added negative limitation of "with the proviso that said extract is derived from a plant other than Ginkgo biloba or Lupinus albus" is new matter.

In Table 4 percent inhibition of MMP-9 by various Solidago preparations is shown and would appear to be relatively ineffective as compared to many other species listed. In Table 14 percent inhibition of migration of cancer cells only a single Solidago preparation from stress A was shown to be relatively effective. Therefore the specification would appear to teach away from the elected species for the function claimed. No active components are disclosed in the specification. And no particular plant parts of Solidago spp. are shown to be extracted by any method. The

Art Unit: 1657

specification as originally presented does not provide written description for one of skill in this art to make the elected invention, an active extract of *Solidago* spp.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 25-30, 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross.

Gross ((Nutr Cancer) entitled “Antineoplastic Activity of *Solidago virgaurea* on Prostatic Tumor Cells in an SCID Mouse Model” teaches in the abstract, *Solidago* has traditionally been used as an antiinflammatory herbal medicine for the treatment of various symptoms. The extract exhibits strong cytotoxic activities on various tumor cell lines. On page 78 column 1 the activity is likely due to a protein factor.

All the features of the claims are taught by Gross for the same function as claimed. The known antiinflammatory activity would be suggestive that the extract inhibits MMP-9 which is associated with inflammation. Regarding the plants being under stress, as claimed any plant would be under stress.

Art Unit: 1657

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 25-30, 36-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

In claim 1 "capable of" does not positively recite what actually occurs. Claim 1 is directed to a plant extract but is incomplete regarding precisely what plant is intended, what part of that plant, and how the extract is prepared. In claim 27 and all occurrences, no Tables are seen.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure is objected to because it is not directed to the elected invention. Correction is required. See MPEP § 608.01(b).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Berrens (5,667,979) teaches protease activity of Solidago pollen in column 13 Table D.

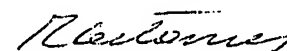
Steinmetz (Codex Vegetabilis) teaches various names for Solidago spp.

Art Unit: 1657

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ralph Gitomer
Primary Examiner
Art Unit 1657